

U.S. Application No. 10/027,215 Examiner Issing, Art Unit 3662
Response to First Office Action

REMARKS

The United States Patent and Trademark Office (the "Office") rejected claims 1-17, 31, and 32 under 35 U.S.C. § 112 for insufficient disclosure. Claims 1-15, 17-32, and 34 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent 6,496,777 to Tennison *et al.*, by U.S. Patent 6,392,565 to Brown, and by U.S. Patent 6,243,039 to Elliot. Claims 16 and 33 were also rejected under 35 U.S.C. § 103 (a) as being unpatentable over any one of Tennison, Brown, or Elliot. Assignee shows, however, that claims 16 and 33 are not obvious, and the Assignee respectively submits that the pending claims are ready for allowance.

Rejection of Claims Under 35 U.S.C. § 112

The Office rejected claims 1-17, 31, and 32 under 35 U.S.C. § 112 for insufficient disclosure. Claims 1-15, 17, 31, and 32, however, have been cancelled with this amendment. Claim 16 was itself amended to cure the § 112 insufficiency.

Rejection of Claims Under 35 U.S.C. § 102

Claims 1-15, 17-32, and 34 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent 6,496,777 to Tennison *et al.*, by U.S. Patent 6,392,565 to Brown, and by U.S. Patent 6,243,039 to Elliot. Claims 1-15, 17-32, and 34 have been canceled with this amendment, so the rejection is moot.

Rejection of Claims Under 35 U.S.C. § 103

Claims 16 and 33 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over any one of Tennison, Brown, or Elliot. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF

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COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition)
(hereinafter "M.P.E.P.").

1. The Prior Art Does Not "Teach or Suggest" The Limitations of Claims 16 and 33

When this criteria is applied, claims 16 and 33 are not obvious. None of the cited references disclose communicating position information "when the battery power of the wireless device reaches a predetermined level." The cited reference to Brown (U.S. 6,392,565) is the only reference that mentions power requirements, and this patent only discusses the low power requirements of the device (*see* column 4, line 67; column 5, lines 21-23; and column 5, lines 54-56). The patent to *Brown*, in fact, repeatedly discusses how a "web host" must first request the position information (*see* column 2, lines 6-10; column 4, lines 10-12; column 5, lines 9-14; and column 6, lines 5-7). *Brown* states that the transceiver "remains in standby, power reducing mode until the web host initiates tracking call 102" (column 5, lines 54-55). One of ordinary skill in the art, then, would not have thought it obvious to modify *Brown* to obviate claims 16 and 33. The prior art does not "teach or suggest" the limitations of claims 16 and 33, so any *prima facie* case must fail. The Assignee, then, respectfully asks the Examiner to remove the rejection.

2. The *Prima Facie* Case of Obviousness Must Fail for Lack of Teaching, Suggestion, or Motivation

Any *prima facie* case for obviousness requires some teaching, suggestion, or motivation to combine/modify the prior art. The prior art, however, fails to identify any teaching, suggestion, or motivation to combine the cited references. The Assignee, then, respectfully asks the Examiner to remove the rejection. *no ref. Combined*

3. The *Prima Facie* Case of Obviousness Must Fail for Lack of Expectation of Success

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Any *prima facie* case for obviousness requires some expectation of success. The prior art, however, fails to identify any expectation of success to combine the cited references. The Assignee, then, respectfully asks the Examiner to remove the rejection. *no ref combined*

Presentation of New Claims

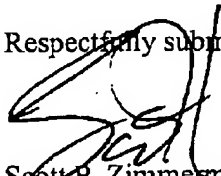
This amendment presents new claims 35-40. These claims depend from amended claims 16 and 33 and incorporate the same patentable limitations.

Change Of Correspondence Address

Examiner Issing, please note a formal Change of Correspondence is submitted with this amendment. The correct correspondence address is Scott P. Zimmerman PLLC, P. O. Box 3822, Cary NC 27519. The phone number is (919) 387-6907, and the fax is (919) 387-6959.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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